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EXAMINER
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BRANDON, MEGAN E

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID BRADELY GRANGER, JACOB MARTINEZ,  
WILLIAM STERLING WYNN, and PAUL LEWIS

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Appeal 2015-000814  
Application 13/363,296  
Technology Center 3700

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Before GEORGE R. HOSKINS, LISA M. GUIJT, and  
PAUL J. KORNICZKY, *Administrative Patent Judges*.

GUIJT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants<sup>1</sup> seek our review under 35 U.S.C. § 134 of the Examiner's decision<sup>2</sup> rejecting claims 1–34. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was conducted on April 14, 2017.

We REVERSE.

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<sup>1</sup> Appellants identify the real party of interest as Spenco Medical Corporation. Appeal Br. 1.

<sup>2</sup> Appeal is taken from the Final Office Action dated March 31, 2014 (“Final Act.”).

### CLAIMED SUBJECT MATTER

Claims 1, 26, and 31 are independent. Claim 1, reproduced below with certain disputed claim limitations italicized for emphasis, is illustrative of the claimed subject matter.

1. An insole which enables generation of an air flow to or from the plantar surface of the foot during use, said insole comprising:

a. a bottom layer having a top side and a bottom side, a heel portion and a toe portion, said heel portion on said bottom side defining a heel recess of sufficient depth and configuration so as to be adapted to receive a heel pad, *said bottom side of said bottom layer further defining a plurality of ridges which protrude outwardly therefrom and extend essentially lengthwise from the heel portion to the toe portion,*

wherein said bottom layer further defines a channel lining portion, wherein adjacent ridges and said channel lining portions define air channels,

whereby when said insole is placed adjacent the inside bottom surface of a user's shoe, a portion of the ridges contact the inside shoe surface, thus sealing said air channels against that surface and forming individual pathways in which air can travel from a first location to a second location within said air channels; and

b. a heel pad situated in said heel recess.

### REJECTIONS

- I. The drawings stand objected to under 37 C.F.R. § 1.83(a).
- II. Claims 12 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

III. Claims 1, 3, 5, 11–18, 22, 26, 28, 29, 31, 32, and 34 stand rejected under 35 U.S.C. § 102(b) as anticipated by Dalton (US 2004/0118017 A1; pub. June 24, 2004).

IV. Claims 2, 4, 7, 8, 21, 23–25, 27, and 33 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dalton and McCormick (US 2006/0254088 A1; pub. Nov. 16, 2006).

V. Claims 6 and 30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dalton and Kolumbuchi (WO 2009/068298 A1; pub. June 4, 2009).

VI. Claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Dalton, McCormick, and Yamada (US 2010/0251577 A1; pub. Oct. 7, 2010).

VII. Claim 10 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Dalton, McCormick, and Seydel (US 6,266,897 B1; iss. July 31, 2001).

VIII. Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dalton.

## ANALYSIS

### *Rejections I and II*

The Examiner objects to the drawings for failing to comply with the requirement that the drawings must show every feature of the invention specified in the claims. Final Act. 2 (citing 37 C.F.R. § 1.83(a)). In particular, the Examiner determines that the following claim limitations are not shown in the drawings of Appellants' Specification: (i) "a secondary middle layer" recited in claims 23–25; and (ii) "[heel] channel portions that are coplanar with said channel lining portions" recited in claim 12. *Id.*

Ordinarily an objection is reviewable by petition under 37 C.F.R. § 1.181 and a rejection is appealable to the Board. *See Ex parte Frye*, 94 USPQ2d 1071, 1077–78 (BPAI 2010) (precedential). Accordingly, the Examiner's objection to the drawings for failing to depict a secondary middle layer as recited in claims 23–25 is a petitionable matter, and not before us on appeal. However, when the issue presented is the same for both an objection and a rejection, the issue is appealable. *See* MPEP § 2163.06(II). Here, claim 12 also stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and the resolution of this issue also resolves the Examiner's objection to the drawings for failing to depict the subject matter of claim 12. Thus, we will decide both the objection and the rejection with respect to claim 12.

"[T]he test for sufficiency [of the written description] is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of

the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (citations omitted). “[T]he written description requirement is satisfied by the patentee’s disclosure of ‘such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.’” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)).

Claim 12 recites, in relevant part, “wherein said concave heel pad comprises . . . heel channel portions that are *coplanar* with said channel lining portions of said bottom layer.” Appeal Br. 33 (Claims App.) (emphasis added). The Examiner determines that because the Specification describes these channels as being “*essentially* coplanar,” there is no written description support for the claim recitation of “coplanar.” Final Act. 4 (emphasis added); *see, e.g.*, Spec. ¶ 49 (“the heel channel portions are essentially coplanar with the channel lining portions”). An ordinary meaning of the term “essentially” is “in an essential manner” or “by its very nature.” WEBSTER’S THIRD NEW INT’L DICTIONARY 777 (1993). Thus, by disclosing that such channels are by their very natures coplanar reasonably conveys to those skilled in the art that Appellants had possession of the concept of such channels being coplanar.

The Examiner also questions whether the coplanar configuration of such channels is possible, because the heel pad is a concave structure. Final Act. 4; Ans. 9; *see also* Appeal Br. 33 (Claims App.) (claim 12 depends from claim 11, which recites “wherein said heel pad is concave”).

Appellants submit that the Specification describes the concavity of the heel pad structure as relating to the thicknesses of the front, middle, and back ends of the inside heel ridges, such that “[t]he effect of the variation in thickness of the inside heel ridges . . . is the formation of the cup-like area.” Appeal Br. 29 (citing Spec. ¶¶ 49–51, 70–72, Fig. 1 (reference numeral 21C)); *see, e.g.*, Spec. ¶ 50 (“the curve gradually changes in thickness”). We agree with Appellants that, in view of the Specification, one of ordinary skill in the art would understand that the concavity of the heel pad is provided by the shape of the top surfaces of the heel ridges, such that the side and bottom walls of heel channel portions 23 may be coplanar with the side and bottom walls of channel lining portions 3, as depicted in Figure 1.

Accordingly, the Examiner erred in determining that the drawings fail to show heel channel portions that are coplanar with said channel lining portions, as recited in claim 12, and, thus, we do not sustain the Examiner’s objection to the drawings. In addition, we do not sustain the Examiner’s rejection of claim 12, and claim 13 which depends therefrom, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

### *Rejection III*

The Examiner finds, *inter alia*, that Dalton discloses ridges between the plurality of channels 130 on the outer surfaces of lateral and medial centering devices 30, 32 that extend essentially lengthwise from the heel portion to the toe portion of a bottom layer of an insole. Ans. 2 (citing Figs. 2, 11A, 11B). The Examiner determines that such ridges “extend along the

length, in a lengthwise manner, of 32 & 30.” *Id.*; *see also* Final Act. 4–5. Appellants argue such ridges “extend only in a transverse pattern . . . that is perpendicular to the length of the insole,” not “in a lengthwise direction from [the] heel [portion] to [the] toe portion,” as required by claim 1. Appeal Br. 13 (citing Dalton ¶ 37, Figs. 2, 8). Appellants submit that “[i]n any plain and ordinary reading of the claim language in Claim 1, one would recognize that the ridges extend along a lengthwise longitudinal axis from the heel to the toe of the insole.” Reply Br. 3.

We find Appellants’ argument persuasive. Claim 1 requires the ridges to extend essentially lengthwise from the heel to the toe portion, and we agree that Dalton’s ridges, which are defined by channels 130, extend transversely across the insole, or perpendicularly relative to the lengthwise dimension defined from the heel to toe portion of the bottom layer of the insole.

Accordingly, we do not sustain the Examiner’s rejection of independent claim 1, and claims 3, 5, 11–18, and 22 depending therefrom as anticipated by Dalton. The Examiner relies on the same findings with respect to Dalton and the same claim limitation as recited in independent claims 26 and 31, and therefore, for the same reasons, we also do not sustain the Examiner’s rejection of independent claims 26 and 31, and claims 28, 29, 32, and 34 depending therefrom as anticipated by Dalton. *See* Final Act. 8–9.



Appeal 2015-000814  
Application 13/363,296

*Rejections IV–VIII*

The Examiner’s reliance on McCormick, Kolumbuchi, Yamada, and Seydel does not cure the deficiency in the Examiner’s finding with respect to Dalton as discussed *supra*, as applied to independent claims 1, 26, and 31. *See* Final Act. 11–17. Therefore, we also do not sustain the Examiner’s rejection of dependent claims 2, 4, 6–10, 19–21, 23–25, 27, 30, and 33.

DECISION

The decision of the Examiner to reject claims 1–34 is REVERSED.

REVERSED